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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/719,602

11/21/2003

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7590 12/27/2006
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EXAMINER

GRAFFEO, MICHEL

ART UNIT

PAPER NUMBER

1614

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

12/27/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/719,602

Applicant(s)

HOLME ET AL.

Examiner

Michel Graffeo

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31,33,35,36,39 and 40 is/are pending in the application.
- 4a) Of the above claim(s) 15,16,18,19,26-28 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14,17,20-25,29-31,33,35,39 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Action

Claims 1-14, 17, 20-25, 29-31, 33, 35 and 39-40 are examined.

Applicant has amended claims 1, 10, canceled claims 32 and 37-38 and provided arguments for the patentability of claims 1-14, 17, 20-25, 29-31, 33, 35 and 39-40 in the response filed 11 August 2006. Pursuant to Applicant's request and amendment to claim 10, claim 10 has been withdrawn from the withdrawn status and is examined.

Applicant's arguments, see response, filed 11 August 2006, have been fully considered but are persuasive to the extent that the rejection under 35 USC § 101 has been withdrawn. In light of the amendments and upon further consideration, a new ground(s) of rejection is made. Any rejection not specifically stated in this Office Action has been withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-14, 17, 20-25, 29-31, 35 and 39-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contain new subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at

Art Unit: 1614

the time the application was filed, had possession of the claimed invention. Specifically, the Specification as filed does not provide a teaching of stain removing components not being mixed directly with the gum base. Contrarily, page 10 first full paragraph of the Specification teaches that the stain removing compounds can actually be encapsulated or embedded.

Claims 1-14, 17, 20-25, 29-31, 35 and 39-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a written description rejection.

Applicant has not conveyed possession of the invention with reasonable clarity to one skilled in the art. In particular, Applicant has not provided a description of stain removing components not being mixed directly with the gum base.

To satisfy the written description requirement, applicant must convey with reasonable clarity to one skilled in the art, as of the filing date that application was in possession of the claimed invention. A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process. See, e.g., *Fujikawa v. Wattanasin*, 93 F.3d 1559, 1571, 39 USPQ2d 1895, 1905 (Fed. Cir. 1996) (a "laundry list" disclosure of every possible moiety does not constitute a written

Art Unit: 1614

description of every species in a genus because it would not "reasonably lead" those skilled in the art to any particular species); In re Ruschig, 379 F.2d 990, 995, 154 USPQ 118, 123 (CCPA 1967).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 11-14, 17, 20-25, 29-33, 35, 37 and 38 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Application No. 2003/0072841 to Rajaiah et al.

Rajaiah et al. teach every limitation elected in the examined claims. Specifically Rajaiah et al. teach a chewing gum (in current claims 1-14, 17, 20-25, 29-33, 35, 37 and 38; see Title) and a method of use (in current claim 33; see paragraph 79) useful to prevent staining (see paragraph 7) which comprises from .01 – 40% carbamide peroxide (see paragraph 39), from 1-25% sodium tripolyphosphate (see paragraph 32), polyvinylacetate (see paragraph 53) and sodium stearate in an amount of up to 30% (see paragraph 62) and further comprising a carrier material such as a wax (in current claims 30-32; see paragraph 14).

Response to Arguments

Applicant's arguments filed 11 August 2006 have been fully considered but they are not persuasive. Applicants argue that the reference teaches a stain removing component as one which is incorporated into an adhesive. That notwithstanding, the reference teaches that the cosmetic actives will be released onto the teeth and to that extent teach a stain removing component which is not materially bound to the gum base. Further, Applicant argues that only one of the components is taught as a stain removing component. But, since a compound and its properties are inseparable, if a component functions as a stain removal, its function will be the same even though the reference does not describe that particular function. Finally, the claim limitation is directed to a negative embodiment of the claim: stain removing components not being mixed directly with the gum base. Not being mixed directly with the gum base is interpreted to mean anything else and since the reference does not teach stain removing components as being directly mixed with the gum base (see Examples) then the reference teaches that which is claimed.

Conclusion

No claim is allowed.

Applicant's amendment to claim 1 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

Art Unit: 1614

MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michel Graffeo whose telephone number is 571-272-8505. The examiner can normally be reached on 9am to 5:30pm Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ardin Marschel can be reached on 571-272-0718. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1614

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

11 December 2006

MG


ARDIN H. MARSCHEL
SUPERVISORY PATENT EXAMINER